

REMARKS

This responds to the Office Action mailed on January 21, 2004.

Claims 1-3, 5-7, 11, 16-20, and 23 have been canceled. Independent claims 8, 12, and 15 have been amended. No claims have been added. As a result, claims 8-10, 12, 15, 21, and 22 are now pending in this application.

For the convenience of the Examiner, Applicant's remarks concerning the claim rejections will be presented in the same order in which the Examiner presented them in the Office Action.

Amendments to Claims 8, 12, and 15

Each of the pending independent claims 8, 12, and 15 has been amended.

Regarding independent claim 8, the words "portable digital" have been inserted into the preamble. Support may be found in the original disclosure, for example, on page 1, line 11 and on page 4, line 19.

The phrase "a lens having a shutter" has been added. Support may be found in the original disclosure, for example, on page 3, line 2.

The phrase "to capture audio input" has been added. Support may be found, for example, in original claim 9.

The processor is now recited as "to convert captured audio input provided by the microphone into either a digital text file or a compressed audio file". Support may be found in the original disclosure, for example, on page 4, lines 2 and 8.

The processor is further recited as "further to convert the captured image into a digital image file". Support may be found, for example, in original claim 8 and on page 4, line 1.

Further, claim 8 now recites the condition "if the captured audio input is converted into a digital text file, the processor is to store the digital image file and the digital text file as a single composite digital data file in the memory and optionally to store the digital text file as a separate file in the memory". Support may be found in the original disclosure, for example, on page 3, lines 29-30 and on page 4, lines 1-4.

In addition, claim 8 now recites the condition "if the captured audio input is converted into a compressed audio file, the processor is to store the digital image file and the compressed audio file as separate files in the memory". Support may be found in the original disclosure, for example, on page 3, lines 29-30 and on page 4, lines 1-4.

Regarding independent claim 12, the words "portable digital" have been inserted into the preamble. Support may be found in the original disclosure, for example, on page 1, line 11 and on page 4, line 19.

Regarding independent claim 15, the words "portable digital" have been inserted into the preamble. Support may be found in the original disclosure, for example, on page 1, line 11 and on page 4, line 19. Also, the word "and" has been added before "storing".

Claim 15 also recites that the audio input is converted "into either text data or a compressed audio file". Support may be found in the original disclosure, for example, on page 4, lines 1-2.

Claim 15 further recites the condition that "if the captured audio input is converted into text data, combining the digital image data and the text data into a single digital data file, and storing the single digital data file in a memory of the camera". Support may be found in the original disclosure, for example, on page 3, lines 29-30 and on page 4, lines 1-4.

In addition, claim 15 further recites the condition that "if the captured audio input is converted into a compressed audio file, storing the digital image data and the compressed audio file as separate files in the memory". Support may be found in the original disclosure, for example, on page 4, lines 8-10.

No new matter has been introduced through these amendments to the claims.

Rejection of Claims 1-3, 5, 7-11, 16-17 and 19
under 35 U.S.C. §102(b)
as Anticipated by Shipp

Claims 1-3, 5, 7-11, 16-17 and 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Shipp (U.S. 6,031,526).

Of this group of rejected claims, only claims 8-10 remain pending and will be discussed below.

Shipp discloses a complex system for generating electronic and printed medical records that provides automatic integration of captured video still images and voice-dictated information concerning the image (see Abstract).

The rule under 35 U.S.C. §102 is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). MPEP §2131.

Shipp does not disclose all of the structural elements recited in independent claim 8, as amended. For example, Shipp fails to disclose a processor to convert captured audio input provided by the microphone into either a digital text file or a compressed audio file. Further, Shipp fails to disclose the condition that if the captured audio input is converted into a compressed audio file, the processor is to store the digital image file and the compressed audio file as separate files in the memory.

For the above reasons, claim 8 should be found to be allowable over Shipp, and Applicant respectfully requests that the rejection of claim 8 under 35 U.S.C. §102(b) as anticipated by Shipp be withdrawn.

Claims 9-10, which depend directly or indirectly from claim 8 and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Rejection of Claims 6 and 18 under 35 U.S.C. §103(a)
as Unpatentable over Shipp

Claims 6 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shipp. Claims 6 and 18 have been canceled.

Rejection of Claims 12, 15, and 20-22 under 35 U.S.C. §103(a)
as Unpatentable over Ishii and Further in View of Shipp

Claims 12, 15 and 20-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii et al. (U.S. 4,742,369) and further in view of Shipp.

Claim 20 has been canceled, but claims 12, 15, 21, and 22 remain pending.

Regarding independent claims 12 and 15, the Examiner stated *inter alia* that Ishii discloses "storing the text data and the digital image data as a single digital data file in a memory of the camera".

Ishii discloses an electronic still camera that enables an image to be previewed on a digital display before being committed to storage on film (refer to Abstract). Ishii also discloses that "a voice input through a microphone 151 is . . . supplied to and recognized by voice recognition circuit 155, and is written in image memory 156" (see col. 14, lines 60-65; refer to FIG. 24).

However, it is noted that Ishii does not disclose combining a text file and an image file into a single digital data file in the memory, contrary to the Examiner's assertion made in the last Office Action. Col. 14, lines 49-66, quoted by the Examiner merely state that "arbitrary additional data", such as keyboard data or voice data, may be stored in image memory 156. Applicant could not find any disclosure in Ishii regarding storing a digital image file and a digital text file as a single composite digital data file in the image memory 156. It is requested that the Examiner specifically identify the portion of Ishii that discloses this, if the Examiner continues to maintain this assertion.

For the above reasons, claims 12 and 15 should be found to be allowable over Ishii in view of Shipp, and Applicant respectfully requests that the rejection of claims 12 and 15 under 35 U.S.C. §102(b) as anticipated by Ishii in view of Shipp be withdrawn.

Claims 21 and 22, which depend from claims 12 and 15, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above.

Rejection of Claim 23 under 35 U.S.C. §103(a)
as Unpatentable over Ishii and Shipp and Further in View of Kondo

Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ishii et al. and Shipp, and further in view of Kondo et al. (U.S. 5,786,851).

Claim 23 has been canceled.

Additional Elements and Limitations

Applicant considers additional elements and limitations of the pending claims to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

Conclusion

Applicant respectfully submits that claims 8-10, 12, 15, 21, and 22 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date March 22, 2004

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of March, 2004.

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Signature